

08-1301

CPA/16198

CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL (Large Entity) Submit an original, and a duplicate for fee processing. <i>(Only for Continuation or Divisional Applications Under 37 CFR 1.53(d))</i>				Docket No. 2870/72	
<input checked="" type="checkbox"/> DUPLICATE <small>(Check box if applicable)</small>					
First Named Inventor		Examiner		Group/Art Unit	
Shah		Berman, A.		1619	
Address to: Assistant Commissioner for Patents Box CPA Washington, D.C. 20231					
This is a request for filing a <input checked="" type="checkbox"/> continuation, or <input type="checkbox"/> divisional application under 37 CFR 1.53(d), (continued prosecution application (CPA)) of prior application number <u>09/248,524</u> filed on <u>February 9, 1999</u> and entitled: Long-Wearing Cosmetic Compositions					
1. <input type="checkbox"/> Enter the unentered amendment previously filed on _____ under 37 CFR 1.116 in the prior nonprovisional application. 2. <input checked="" type="checkbox"/> A preliminary amendment is enclosed. 3. <input type="checkbox"/> This application is being filed by fewer than all the inventors named in the prior application, 37 CFR 1.53(d)(4). a. <input type="checkbox"/> DELETE the following inventor(s) named in the prior nonprovisional application: b. <input type="checkbox"/> The inventor(s) to be deleted are set forth on a separate sheet attached hereto. 4. <input type="checkbox"/> A new power of attorney or authorization of agent is enclosed. 5. <input type="checkbox"/> An Information Disclosure Statement (IDS) is enclosed: a. <input type="checkbox"/> PTO-1449 b. <input type="checkbox"/> Copies of IDS Citations 6. <input type="checkbox"/> The fee for this application is calculated as follows:					
CLAIMS AS FILED					
For	#Filed	#Allowed	#Extra	Rate	Fee
Total Claims	22	- 20 =	2	x \$18.00	\$36.00
Indep. Claims	4	- 3 =	1	x \$80.00	\$80.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
BASIC FEE					\$710.00
TOTAL FILING FEE					\$826.00

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CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL (Large Entity)
(Only for Continuation or Divisional Applications Under 37 CFR 1.53(d))

7. ☒ The Commissioner is hereby authorized to credit overpayments or charge the following fees to
Deposit Account No. 05-1320

- ☒ fees required under 37 C.F.R. 1.16.
- ☒ fees required under 37 C.F.R. 1.17.
- ☐ fees required under 37 C.F.R. 1.18.

8. ☐ A check in the amount of _____ is enclosed.

9. ☒ Also enclosed:
Petition for Extension of Time

10. ☐ The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address
is provided below:

CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL (Large Entity)
(Only for Continuation or Divisional Applications Under 37 CFR 1.53(d))

NOTES

Submit an original, and a duplicate for fee processing.

FILING QUALIFICATIONS: The prior application must be a nonprovisional application that is either: (1) complete as defined by 37 C.F.R. 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. A Notice will be placed on a patent issuing from a CPA, except for reissues and designs, to the effect that the patent issued on a CPA and is subject to the twenty-year patent term provisions of 35 USC 154(a)(2). Therefore, the prior application of a CPA may have been filed before, on or after June 8, 1995.

C-I-P NOT PERMITTED: A continuation-in-part application cannot be filed as a CPA under 37 C.F.R. 1.53(d), but must be filed under 37 C.F.R. 1.53(b).

EXPRESS ABANDONMENT OF PRIOR APPLICATION: The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 C.F.R. 1.53(b) must be used to file a continuation, divisional or continuation-in-part of an application that is not to be abandoned.

ACCESS TO PRIOR APPLICATION: The filing of this CPA will be construed to include a waiver of confidentiality by the Applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 C.F.R. 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or application in the file jacket.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 C.F.R. 1.78(a).

Dated:

August 9, 2001

Estelle J. Tsevdos
Signature

ESTELLE J. TSEVDOS

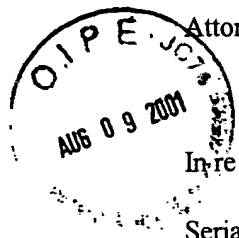
Typed or printed name

31,145

Registration Number (if applicable)

- ☐ Inventor(s)
☐ Assignee of complete interest
☒ Attorney or agent of record

cc:



Attorney Docket No.: 2870/72

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shah

Serial No.: 09/248,524

Group Art Unit: 1619

Filed: February 9, 1999

Examiner: Berman, Alysia

For: Long-Wearing Cosmetic Compositions

#16
AKD
8-15-01

PRELIMINARY AMENDMENT

Assistant Commissioner of Patents and Trademarks

Washington, D.C. 20231

Dear Sir:

The following Preliminary Amendment is submitted as a further response to the Final Office Action dated February 12, 2001 and the Advisory Action dated June 12, 2001. Applicants previously filed, on July 12, 2001, a Response to comments made by the Examiner in the Advisory Action. The Examiner issued a second Advisory Action of August 2, 2001 with comments regarding the cited references. Applicants respond to the comments, and also file concurrently herewith a continued prosecution application. Accordingly, it is requested that the following remarks be considered.

In the present Advisory Action, Claims 1 to 22 are rejected by the Examiner as being unpatentable because the '072 reference discloses organic pigments, in general, and is not limited to water-soluble or water-insoluble organic pigments. Further, the Examiner asserts that compositions disclosed in the '072 specification do not require oil or wax nor do they require that the pigments be incorporated into an oil or wax phase. However, previously, the Examiner asserted in the Final Office Action of February 12, 2001, that water-soluble organic pigments of the '277 reference can be substituted with the water-insoluble organic pigments of the '072 reference to achieve the present invention. Therefore, it is the focus made by the Examiner on the teaching of water-insoluble organic pigments in the '072 reference that leads to the attention given to the '072 water-insoluble organic pigments (see Page 3 of Final Office Action of February 12, 2001). Applicants believed that the Examiner had narrowed the issue to advance the examination of the present invention, and thus, Applicants responded only that these two types of pigments are not interchangeable when considering the cited references as a whole, and therefore, they do not, alone or in combination, render the present invention obvious. Obviousness is found if the subject matter as a whole would have been obvious at the time the invention was made to one of ordinary skill in the art to which said subject matter pertains. 35 U.S.C. Section 103(a) (1994); *see Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d

1614, 1616.

The present invention relates to long-wearing compositions comprising an acrylic or methacrylic acid derived polymeric or copolymeric component in combination with at least one water-soluble organic pigment. The composition is water resistant and does not run or settle into lines and creases on the skin. Contrary to the Examiner's comments in the present Advisory Action, the '072 reference does not teach organic pigments in general. The '072 pigments, which includes organic pigments, are limited by the '072 specification when read in its entirety. In determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, the references "must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention." *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1481, 1 USPQ2d 1241, 1246 (Fed. Cir. 1986); *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) ("In effect, [the prior art] teaches away from the board's proposed modification"); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ 1593, 1597 (Fed. Cir. 1987) (a prior art reference "must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention in suit").

Previously, in Applicants' Responses of June 15, 2000, page 6, and December 5, 2000, page 3, Applicants demonstrated that, when examined as a whole, the '072 reference teaches a specific type of pigment that is water insoluble. The '072 reference fails to teach or suggest water soluble pigments. Consequently, none of the water-soluble components of the '277 reference are interchangeable with the water-insoluble components of the '072 reference because anything water-soluble and water-insoluble is considered by one of ordinary skill in the art to be opposites, and to therefore, function in divergent roles. Thus, it is further demonstrated that the present invention is non-obvious.

In the present Advisory Action of August 2, 2001, the Examiner also explains that the '072 reference does not require oil or wax and that it does not require that pigments be incorporated into an oil or wax phase. However, Applicants assert only what the '072 reference teaches as one of ordinary skill in the art would only combine references based on what is taught or suggested in the art. The '072 reference is an example of what is known in the art, and specifically, at column 7, the '072 reference describes Processing Directions wherein it teaches that pigments are added to oil dispersible or oil soluble components, and that pigments are added to hydrophobic materials. Therefore, one of ordinary skill in the art based on the teachings of the '072 reference would expect and understand that the water insoluble pigments are dispersed in a suitable oil or hydrophobic phase. The Examiner has failed to provide any evidence or reasoning to

support why one of ordinary skill in the art would incorporate water insoluble pigments in anything but oil.

Applicants have repeatedly pointed out that the '072 reference teaches oil and wax as an optional ingredient, as for example, Applicants previously pointed this out in their Response of December 5, 2000, at page, 7, lines 3 to 10, and in their Response of July 12, 2001. However, as the '072 reference teaches, and as one of ordinary skill in the art would know and understand, pigments are incorporated in oil, therefore, when water insoluble pigments are present so is oil because this is the dispersant phase for the water insoluble pigment. They go hand in hand. Therefore, one of ordinary skill in the art, based on the teachings of the '072 reference, would know and understand that both the water insoluble pigments and the hydrophobic phase are present in the compositions of the '072 reference.

Thus, one of ordinary skill in the art would not interchange the water-insoluble pigments of the '072 reference with the water soluble pigments of the '277 reference because the resultant composition would be expected to experience clogging problems due to the presence of oil and wax. As previously elaborated upon in Applicants Responses of May 14, 2001 and July 12, 2001, the '277 reference teaches that wax or oil causes clogging and other adverse effects. The combination of the cited references proposed by the Examiner would take the water-soluble pigments out of the compatible water-based '277 compositions and into the incompatible oil or wax of the '072 emulsion. One of ordinary skill in the art would find this to be highly illogical, and therefore, there is no motivation to combine these references to make a *prima facie* case of obviousness against the present invention.

Even if the water-soluble pigments of the '277 reference could be incorporated in the '072 compositions, this combination does not make the present invention which has a single acrylic based polymeric component combined with water-soluble organic pigments. The combination of the '072 and the '277 references is still a combination of water-soluble and water-insoluble polymers in an emulsion and this is not the present invention. The present invention is a composition comprising a simple polymeric component of an acrylic acid derived polymer or copolymer and at least one water-soluble organic pigment, and the benefits derived therefrom are not taught or suggested by the combination of cited references even if the water-soluble pigments of the '277 reference could be substituted for the water-insoluble pigments of the '072 reference.

In view of the arguments presented above in the present submission, the claims are believed to be in condition for allowance because there is no motivation to combine the '072 and the '277 references and because the combination of these cited references fails to teach or suggest the present invention. Therefore,

- Applicants submit that the claims of the present application satisfy the requirements of 35 U.S.C. §103(a). Accordingly, Applicants request that the rejection under 35 U.S.C. §103(a) be withdrawn and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

Dated: August 9, 2001

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